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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,512	05/07/2007	Marty A Barris	00758.1916USWO	8327

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EXAMINER
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CLEMENTE, ROBERT ARTHUR

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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06/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,512	<b>Applicant(s)</b> BARRIS ET AL.	
	<b>Examiner</b> ROBERT A. CLEMENTE	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20060815</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/547,759, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The '759 provisional application does not disclose a media including continuous, extruded fibers with an added binder resin content, if any, of no greater than 7% by weight of total fiber material; the continuous fibers being bonded at spaced locations. Accordingly, claims 1 - 6 are not entitled to the benefit of the prior application.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 - 5 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7,309,372 to Kahlbaugh et al.

As discussed above, claims 1 - 6 of the instant application are not entitled to the benefit of Provisional Application No. 60/547,759, filed February 23, 2004. The '372 patent to Kahlbaugh claims priority to Provisional Application No. 60/625,439, filed November 5, 2004. All of the relevant structure in Kahlbaugh, as discussed below, is supported in the '439 provisional application. Thus, Kahlbaugh qualifies as prior art under 35 U.S.C 102(e).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Kahlbaugh teaches a filter medium that inherently could be used as “a first media stage” in a “crankcase ventilation filter” as these terms do not provide any structure to the media and the media of Kahlbaugh includes all of the structural limitations of claim 1 of the instant application. As disclosed in column 6 lines 42 - 52, the media of Kahlbaugh includes media fiber and a bicomponent fiber. Bicomponent fibers are inherently continuous, extruded fibers. As disclosed, the fibers are bonded together using the bicomponent fibers, thus the bicomponent fibers are bonded at spaced locations. Kahlbaugh discloses that an additional resin binder is optional, thus the media could be produced without any resin binder. As shown in Table 1 (below columns 15 and 16), the media can be used to filter crankcase blowby and the bicomponent fiber can have a diameter, or cross-sectional size, of at least 10 microns. As shown in the continuation of Table 1 (above columns 17 and 18), the media can be made with pore size that falls within the claimed range of 10 - 60 microns. The pore size is inherently measured in a linear direction. Applicant has not defined the claimed “X-Y direction” to be any specific direction. Thus, the calculated pore size of Kahlbaugh inherently can be considered to be measured in the X-Y direction.

In regard to claim 2, as disclosed in column 22 lines 9 - 11, the media of Kahlbaugh can be formed as a tubular construction.

In regard to claim 3, as disclosed in column 22 lines 14 - 20, a pleated cylindrical media, which forms a tubular media, is imbedded in end caps. Thus, the media is positioned in extension between first and second end caps.

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In regard to claim 4, as discussed above, the media can be made without any binder resin. Thus, the media inherently includes no more than 3%, by weight, added binder resin.

In regard to claim 5, as discussed above, Kahlbaugh includes bicomponent fibers in the media.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,290,739 to Gieseke et al. in view of Kahlbaugh.

Gieseke teaches a crankcase ventilation filtration assembly (50), as best shown in figures 2 and 4. The assembly (50) includes a housing (52). The housing (52) includes a gas flow inlet arrangement (58), a gas flow outlet arrangement (60), and a

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liquid drain outlet arrangement (62). The media filter (66) can be considered a first media stage and forms a serviceable crankcase ventilation filter operably positioned within the housing (52). Gieseke does not disclose forming the media filter (66) with media having the structural limitations of claim 1 of the instant application. As discussed above in section 3, Kahlbaugh teaches a filter media capable of use as a crankcase ventilation media filter having all of the claimed limitations of the “first media stage”.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gieseke to include a media filter including a media of the type of Kahlbaugh since this media is known to be effective as a media for filtering crankcase blowby.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 -6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 3, 5, and 12 of copending Application No. 11/883,690. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 - 3, 5, and 12 of the '690 application disclose all of the structure of claims 1 - 6 of the instant application except for continuous fibers being bonded at spaced locations. The bicomponent fibers in the '690 application are inherently continuous, extruded fibers. It is well known in the art to use bicomponent fibers to bond fibers together at spaced locations. Thus, it would have been obvious to one of ordinary skill in the art to heat the bicomponent fibers in the '690 application to bond them together at spaced locations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Other prior art references listed on the PTO-892 (Notice of References Cited) are considered to be of interest disclosing similar filter media and crankcase ventilation filtration assemblies.



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT A. CLEMENTE whose telephone number is (571)272-1476. The examiner can normally be reached on M-F, 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RAC

/DUANE SMITH/  
Supervisory Patent Examiner, Art Unit 1797